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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,713	08/14/2000	Ismail Dalgic	3COM-2399-CTO	2655

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EXAMINER

KANG, PAUL H

ART UNIT PAPER NUMBER

2141

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/639,713

Applicant(s)

DALGIC ET AL.

Examiner

Paul H Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Priority

1. The Applicant has claimed the benefit of an earlier filing date of a Patent Application under 35 CFR 120. However, benefit of the earlier filing date will not be granted regarding newly added features “for performing authentication” claimed in the present Application.

This application is a CIP of pending U.S. Patent Application Serial No. 09/181,431, filed October 30, 1998 and entitled “METHOD, APPARATUS AND COMMUNICATIONS SYSTEM FOR COMPANION INFORMATION AND NETWORK APPLIANCES”.

Upon review of the previously filed pending applications, it has been determined that the presently claimed features relating to the system and method “for performing authentication” was newly added to this patent application. Therefore, priority to an earlier application was not granted for this feature. Accordingly, the effective priority date for the newly added features found in the present application will be the actual filing date of this Patent Application, August 14, 2000.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is generally narrative and indefinite, failing to conform with current U.S. practice. Lines 12-14 contain grammatical errors; there is no verb/linking verb associated with

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the subject "cradle." In line with the previous grammatical format found on lines 10-11, lines 12-14 should read in part "wherein said cradle **IS** for receiving..." Correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 11-13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard, US Pat. No. 5,497,339, in view of Sitaraman et al., US Pat. No. 6,466,977.

4. As to claims 1 and 11, and 19, Bernard teaches the invention substantially as claimed. Bernard teaches a data system comprising a cradle for receiving a portable computer system and also coupled to communicate with said LAN without going through said phone (Bernard teaches a system for integrating a PDA to communicate via multiple communication media; Bernard, col. 1, line 39 – col. 2, line 14 and col. 3, line 8 – col. 4, line 52).

However, Bernard does not explicitly teach a system and method for authenticating a user to access the multiple communication media. In the same field of endeavor, Sitaraman teaches a system and method for controlling access to a communications network. Specifically, Sitaraman teaches:

a local area network (LAN) comprising a hub/switch and coupled to a server, said LAN for coupling with a Public Switched Telephone Network for communication therewith; an

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ethernet phone coupled to communicate with said LAN; wherein said hub/switch is for detecting a connection to a portable computer system and for performing authentication in response thereto (Sitaraman, col. 4, lines 25-57 and col. 6, line 24 – col. 7, line 13);

wherein receiving user authentication data from said portable computer system and transmitting said user authentication data to said server (Sitaraman, col. 6, line 24 – col. 7, line 13); and

wherein said server is for opening a port on said hub/switch allowing said ethernet phone to communicate voice data over said LAN and also allowing said cradle access to said LAN provided said authentication is successful and otherwise for causing said hub/switch to block said ethernet phone and said cradle from accessing said LAN (Sitaraman, col. 6, line 24 – col. 7, line 13).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the user authentication for network access, as taught by Sitaraman, into the system of Bernard, for the purpose of managing and controlling network access.

5. As to claims 2 and 12, Bernard-Sitaraman further teach said system and method comprising a serial LAN converter and wherein said cradle is coupled to a serial port of said serial to LAN converter and wherein said serial to LAN converter is coupled to said hub/switch of said LAN (Bernard, col. 3, line 59 – col. 4, line 15).

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6. As to claims 3 and , Bernard-Sitaraman further teach said system and method further comprising a Voice Over IP (VOIP) Gateway and a non-ethernet telephone and wherein said non-ethernet telephone is coupled to said VOIP Gateway and wherein said VOIP Gateway is coupled to said hub/switch of said LAN (Sitaraman, col. 6, line 24 – col. 7, line 13).

7. As to claims 4 and 13, Bernard-Sitaraman further teaches said system and method further comprising wherein said server utilizes backend AAA infrastructure to perform said authentication (Sitaraman, col. 6, line 24 – col. 7, line 13).

8. Claims 5-9 and 14-17 are rejected over Bernard-Sitaraman, as applied above, and further in view of Kimball et al., US Pat. No. 5,859,959.

9. As to claims 5 and 14, Bernard-Sitaraman teach the invention substantially as claimed. However, Bernard-Sitaraman does not explicitly teach said system and method wherein said connection is detected by a linkbeat signal. In the same field of endeavor, Kimball teaches the use of a linkbeat signal to detect working connections (Kimball, col. 1, lines 21-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a linkbeat signal, as taught by Kimball, into the communication system of Bernard-Sitaraman, for the purpose incorporating redundancy and enhancing system reliability.

10. As to claims 6 and 15, Bernard-Sitaraman-Kimball further teach said system and method further comprising wherein said user authentication data comprises a user identity and user

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billing information.

11. As to claim 7, Bernard-Sitaraman-Kimball further teach said system and method further comprising wherein said user authentication data is encrypted.

12. As to claims 8 and 16, Bernard-Sitaraman-Kimball further teaches said system and method further comprising wherein said portable computer system is a personal digital assistant (PDA) (Bernard, col. 3, line 59 – col. 4, line 15).

13. As to claims 9 and 17, Bernard-Sitaraman-Kimball further teach said system and method further comprising wherein said portable computer system comprises a display screen for displaying status information regarding said authentication (Bernard, col. 1, lines 19-35).

14. Claims 10 and 18 are rejected over Bernard-Sitaraman-Kimball, as applied above, and further in view of Atkinson, US Pat. App. No. US 2001/0054180 A1.

15. As to claims 10 and 18, Bernard-Sitaraman-Kimball the invention substantially as claimed. However, Bernard-Sitaraman-Kimball does not explicitly teach said system and method further comprising wherein said ethernet phone and said cradle are located in proximity to each other within a phone booth. In the same field of endeavor, Atkinson teaches a kiosk/phone booth in a public place (Atkinson, page 8, paragraphs 0075-0078). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the

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kiosk/phone booth as taught by Atkinson, into the communication system of Bernard-Sitaraman-Kimball for the purpose of increasing interactive aspects of mobile computing devices in public places.

Response to Arguments

Applicant's arguments filed June 30, 2004 have been fully considered but they are not persuasive. The applicant cited MPEP 201.08, reading this passage as requiring the Office to grant the claimed priority date to newly added disclosure in a Continuation-in-Part application.

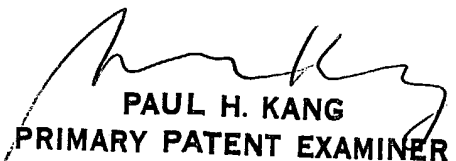
The examiner disagrees with the applicant's reading of the cited portion of the MPEP. This section provides that an applicant is "permitted to claim the benefit of the filing date of an earlier nonprovisional application if the alleged continuation-in-part application complies with the ... formal requirements of 35 USC 120..." However, if this claim for priority is challenged, for instance by the Office in relying a prior art reference having a priority date before the date of filing of the CIP but after the priority date, then the applicant must show that the requirement of 35 USC 112 has been met. "Unless the filing of the earlier nonprovisional application is actually needed, for example, in the case of an interference or to overcome a reference, there is no need for the Office to make a determination as to whether the requirement of 35 USC 120...is met..." Because in the present case the applicant must "overcome a reference," applicant must show that requirements if 35 USC 112 has been met as to the newly added limitations. "User access parameter" cited as being disclosed in the parent application is not deemed sufficient to satisfy the 35 USC 112 requirements for the invention as claimed.

Additionally, the applicant noted that the Prior Office action was unclear as to whether Bernard reference is taken in combination with Nada or Sitaraman. Citation of Nada in place of Sitaraman was a typographical error and has been corrected in the present Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. After October 26, 2004, all calls should be placed to (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL H. KANG
PRIMARY PATENT EXAMINER